

Confirmation no. 8224

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	VINK	Examiner:	Cardwell, E.
Serial No.:	10/561,461	Group Art Unit:	2189
Filed:	December 20, 2005	Docket No.:	NL030719US1 (NXPS.472PA)

Title: STORAGE DEVICE FOR STORING DIFFERENT DATA FORMATS

APPEAL BRIEF

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Customer No. 65913

Dear Sir:

This Appeal Brief is submitted pursuant to 37 C.F.R. §41.37, in support of the Notice of Appeal filed June 26, 2009 and in response to the rejections of claims 1-9 as set forth in the Final Office Action dated January 26, 2009.

Please charge Deposit Account number 50-4019 (NL030719US) \$540.00 for filing this brief in support of an appeal as set forth in 37 C.F.R. §1.17(c). If necessary, authority is given to charge/credit Deposit Account 50-0996 additional fees/overages in support of this filing.

I. Real Party In Interest

The real party in interest is NXP Semiconductors. The application is presently assigned of record, at reel/frame nos. 019719/0843 to NXP, B.V., headquartered in Eindhoven, the Netherlands.

II. Related Appeals and Interferences

While Appellant is aware of other pending applications owned by the above-identified Assignee, Appellant is unaware of any related appeals, interferences or judicial proceedings that would have a bearing on the Board's decision in the instant appeal.

III. Status of Claims

Claims 1-9 stand rejected and are presented for appeal. A complete listing of the claims under appeal is provided in an Appendix to this Brief.

IV. Status of Amendments

No amendments have been filed subsequent to the Final Office Action dated January 26, 2009.

V. Summary of Claimed Subject Matter

As required by 37 C.F.R. § 41.37(c)(1)(v), a concise explanation of the subject matter defined in the independent claims involved in the appeal is provided herein. Appellant notes that representative subject matter is identified for these claims; however, the abundance of supporting subject matter in the application prohibits identifying all textual and diagrammatic references to each claimed recitation. Appellant thus submits that other application subject matter, which supports the claims but is not specifically identified above, may be found elsewhere in the application. Appellant further notes that this summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and their legal equivalents for a complete statement of the invention.

Commensurate with independent claim 1, an example embodiment of the present invention is directed to a storage device (*see, e.g.*, storage device 2 shown in Fig. 1, and page 5:7-17) for storing data pieces and comprising: an input for receiving first data pieces

having a first data format (*see, e.g.*, input 27 shown in Fig. 1, and page 5:26-34); a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format (*see, e.g.*, transcoder 22 shown in Fig. 1, and page 6:12-13); a storage medium for storing a set of first data pieces and a subset of second data pieces (*see, e.g.*, storage medium 23 shown in Fig. 1, and page 7:1-20); and a processor (*see, e.g.*, processor 20 shown in Fig. 1) for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to a reproduction device (*see, e.g.*, reproduction device 3 shown in Fig. 1, and page 5:18-25) and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device (*see, e.g.*, page 6:1-15).

Commensurate with independent claim 6, an example embodiment of the present invention is directed to a system comprising a reproduction device (*see, e.g.*, reproduction device 3 shown in Fig. 1, and page 5:18-25) and a storage device (*see, e.g.*, storage device 2 shown in Fig. 1, and page 5:7-17) for storing data pieces and comprising: an input for receiving first data pieces having a first data format (*see, e.g.*, input 27 shown in Fig. 1, and page 5:26-34); a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format (*see, e.g.*, transcoder 22 shown in Fig. 1, and page 6:12-13); a storage medium for storing a set of first data pieces and a subset of second data pieces (*see, e.g.*, storage medium 23 shown in Fig. 1, and page 7:1-20); and a processor (*see, e.g.*, processor 20 shown in Fig. 1) for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device (*see, e.g.*, page 6:1-15).

Commensurate with independent claim 7, an example embodiment of the present invention is directed to a processor (*see, e.g.*, processor 20 shown in Fig. 1) for use in a storage device (*see, e.g.*, storage device 2 shown in Fig. 1, and page 5:7-17) for storing data

pieces, which storage device comprises: an input for receiving first data pieces having a first data format (*see, e.g.*, input 27 shown in Fig. 1, and page 5:26-34); a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format (*see, e.g.*, transcoder 22 shown in Fig. 1, and page 6:12-13); a storage medium for storing a set of first data pieces and a subset of second data pieces (*see, e.g.*, storage medium 23 shown in Fig. 1, and page 7:1-20); and the processor for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to a reproduction device (*see, e.g.*, reproduction device 3 shown in Fig. 1, and page 5:18-25) and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device (*see, e.g.*, page 6:1-15).

Commensurate with independent claim 8, an example embodiment of the present invention is directed to a method for supplying data pieces to a reproduction device (*see, e.g.*, reproduction device 3 shown in Fig. 1, and page 5:18-25) and comprising the steps of: receiving first data pieces having a first data format (*see, e.g.*, page 5:26-34); transcoding a first data piece into a second data piece having a second data format different from the first data format (*see, e.g.*, page 6:12-13); storing a set of first data pieces and a subset of second data pieces in a storage medium (*see, e.g.*, storage medium 23 shown in Fig. 1, and page 7:1-20); and searching the storage medium for a predefined second data piece for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device (*see, e.g.*, page 6:1-15).

Commensurate with independent claim 9, an example embodiment of the present invention is directed to a processor program product (*see, e.g.*, page 9:29 to page 10:4) for supplying data pieces to a reproduction device (*see, e.g.*, reproduction device 3 shown in Fig. 1, and page 5:18-25) and comprising the functions of: receiving first data pieces having a first data format (*see, e.g.*, page 5:26-34); transcoding a first data piece into a second data piece having a second data format different from the first data format (*see, e.g.*, page 6:12-

13); storing a set of first data pieces and a subset of second data pieces in a storage medium (*see, e.g.*, storage medium 23 shown in Fig. 1, and page 7:1-20); and searching the storage medium for a predefined second data piece for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device (*see, e.g.*, page 6:1-15).

VI. Grounds of Rejection to be Reviewed Upon Appeal

The grounds of rejection to be reviewed on appeal are as follows:

- A. Claims 1-9 stand rejected under 35 U.S.C. §103(a) over the Widergren reference (U.S. Patent Pub. 2004/0228169) in view of the Chouinard reference (U.S. Patent No. 6,671,701).

VII. Argument

A. The § 103(A) Rejection Is Improper Because The Cited References Do Not Disclose Searching For And Supplying Stored Transcoded Data When Available And Generating Transcoded Data When A Stored Version Is Unavailable

The § 103(a) rejection is improper because the cited combination of the ‘169 and ‘701 references lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) which concerns searching for data in a desired format and, if not found, converting the data to the desired format. By storing certain data in the desired format (*e.g.*, frequently accessed data), faster access to the stored data is achieved without the need for large amounts of storage space. Neither ‘169 reference nor the ‘701 reference is concerned with such important aspects of the claimed invention and, therefore, the asserted combination is improper because of its failure to appreciate the claimed invention “as a whole.” With reference to Appellant’s claims, these important aspects include searching for and supplying a stored “predefined second data piece” when the second data piece is available, and “transcoding a corresponding first data

piece into the predefined second data piece” when the second data piece is unavailable (*e.g.*, as in the last clause of claim 1). Because neither reference teaches these aspects, no reasonable combination of these references can provide correspondence to the claimed invention. As such, in the context of *KSR*, the asserted combination “as a whole” is entirely unpredictable based on the asserted teachings of the cited references. Moreover, the Examiner appears to be improperly combining the cited references in the manner taught by Appellant’s disclosure in an improper hindsight reconstruction of the claimed invention, as is discussed in more detail below heading D.

The above discussed “correspondence-based” difficulties can be appreciated in the context of the last two clauses of claim 1. For example, the ‘169 reference does not teach storing second data pieces on a storage medium (as acknowledged by the Examiner) and, as such, the ‘169 reference also fails to disclose the claimed aspects directed to searching for and supplying a stored predefined second data piece when it is available, and transcoding a corresponding first data piece into the predefined second data piece when it is unavailable. The related claim limitations of the instant application are directed to processing incoming “first” data in a first format to provide “second” data (corresponding to the first data) in a format that is different than the first format by either generating the second data or retrieving the second data from storage (if available). The ‘701 reference also fails to teach such aspects of the claimed invention. Instead, the ‘701 reference (at column 3 and in claim 1) discloses a processor that searches for source files of a first format and, if encountering the stored file for the first time, translates the stored file into a second format. The cited portions of the ‘701 reference thus fail to disclose a processor that searches for a stored file in a *second* (transcoded) format and that supplies the stored file in the second format to a reproduction device if found, and in response to not finding the file, transforming received data corresponding to the file from a first format into the second format and supplying the transformed data to the reproduction device. In this regard, the ‘701 reference does not correspond to the claimed processor and its functions for supplying a predefined second data piece and controlling a transcoder for transcoding a corresponding first data piece if the predefined second (transcoded) data piece is not found in the storage medium.

In view of the above, the cited combination does not correspond to the claimed invention. Accordingly, the Appellant respectfully submits that the § 103(a) rejection is improper and requests that it be withdrawn.

B. The § 103(A) Rejection Is Improper Because The ‘169 Reference Teaches Away From Storing Data In A Second Data Format

The ‘169 reference teaches away from transcoding multimedia content 50 into a second format and storing the transcoded content in memory 40 as proposed by the Examiner. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘169) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). In this instance, referring to paragraphs 0004 and 0008-0013, the ‘169 reference stores a “first data set” in a first format (*e.g.*, the data is encoded and/or encrypted) and uses an executable “second data set” to produce the first data set in a different format (*e.g.*, uses executable decryption software to decrypt multimedia data). The processed first data set does not appear to be stored, and such storage would appear to defeat the purpose of the ‘169 reference, which is achieved by storing data in a first format together with software on a memory that is used to provide the data in a different format. This purpose is useful for ensuring that any decrypted data “can thus not be copied easily by a user into another unencrypted file for subsequent non-encrypted playback” as discussed in paragraph 0032. Combining the ‘701 reference’s approach to storing a first data set and also storing data in a second processed or decrypted format would thus undermine this purpose of the ‘169 reference, as acknowledged by the Examiner’s assertion that such a combination would “give up this security.” As such, the ‘169 reference teaches away from such a modification and the Examiner’s proposed combination is improper.

Moreover, the device of the ‘169 reference is designed to be compatible with multiple different types of electronic systems that process data in different formats, such that

converting data into a predefined format, prior to delivery, would render the respective systems' ability to process different formats unnecessary (and effectively inoperable). The '169 reference includes multiple different decoder software programs 60a-60c and multiple different decryption software programs 70a-70c in order to enable the file 50 to be decoded to the format required by the current system that the card 10 is interfaced with. *See, e.g.*, paragraph 0015. The Examiner fails to provide any explanation regarding how converting part of file 50 to a second format and storing it in the memory 40 would enhance "operation speed in providing the file to the user" when the device of the '169 reference interfaces with systems that are not compatible with the second format. Moreover, the Examiner's proposed modification results in "reduced security" (*e.g.*, by removing encryption) which further contradicts the stated purpose of the reference as discussed above.

In view of the above, Appellant respectfully submits that the § 103(a) rejection is improper and requests that it be withdrawn.

C. The § 103(A) Rejection Impermissibly Relies Upon Appellant's Disclosure As Motivation For Storing A Subset Of Second Data Pieces

The Examiner has impermissibly used Appellant's teachings as the basis for the conclusion of obviousness, and in doing so has failed to comply with the requirements of § 103. In this instance, the Examiner's assertions regarding only storing "some of the files in the decoded format" requires that the skilled artisan impermissibly work backward from Appellant's specification. As discussed above, the '169 reference does not teach storing any files in a second format, whereas the '701 reference teaches translating all of the files of the first format into a second format. Appellant notes that the Examiner's various assertions (*see* page 5 of the Final Office Action) regarding why the skilled artisan would store "some of the files in the decoded format" are not supported by any evidence of record (*e.g.*, prior art); as such, the Examiner's assertions are mere unsupported conclusions upon which it is improper to base a rejection. Absent Appellant's specification, there is no evidence of record that would suggest to the skilled artisan that only storing "some of the files in the decoded format" would be advantageous. Accordingly, Appellant respectfully submits that the § 103(a) rejection is improper and requests that it be withdrawn.

D. In Attempting To Use An Obvious-To-Try Argument, The § 103 Rejection Contradicts Both The Patent Law And The Evidence That The ‘169 Reference Teaches Away From The Examiner’s Asserted Modification

The § 103 rejection is improperly based on an “obvious to try” assertion that ignores the teaching-away evidence (discussed above) and contradicts one of the two situations, as explained in *In re Kubin*, in which the “obvious to try” standard may not be applied. With regard to the Examiner’s discussion of Appellant’s alleged admitted prior art (*see* page 3 of the Final Office Action), Appellant notes that none of these teachings are alleged to disclose only storing “some of the files in the decoded format.” While the rejection presented for Appeal is not based on this alleged admitted prior art, Appellant submits that the Examiner’s assertions are based on an “obvious to try” assertion that contradicts one of the two situations, as explained in *In re Kubin*, in which the “obvious to try” standard may not be applied. Specifically, the evidence of record does not indicate that Appellant’s alleged admitted prior art provides any direction as to which of many possible choices of only storing “some of the files in the decoded format” is likely to be successful. Without further explanation, the record indicates that, at best, the Examiner’s assertions are based solely on “obvious to try” arguments. Such a rejection, however, has been reviewed and assessed adversely by the *In re Kubin* court which explains that the “obvious to try” standard may not be applied where one would have “to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” *In re Kubin* (Fed. Cir. April 3, 2009), *interpreting KSR*. *See also* M.P.E.P. § 2143(E), and *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 725 (Fed. Cir. 1990) (“we have consistently held that ‘obvious to try’ is not to be equated with obviousness.”).

In view of the above, Appellant respectfully submits that the § 103(a) rejection is improper and requests that it be withdrawn.

**E. The § 103(A) Rejection Of Claim 5 Is Improper Because
the Examiner Improperly Relies Upon Official Notice**

The § 103(a) rejection of claim 5 is improper because the Examiner improperly relies upon “Official Notice” in attempting to assert correspondence to claim 5 without providing the requisite documentary evidence and motivation for why the skilled artisan would modify the ‘169 to include the allegedly well-known aspects. *See, e.g.*, M.P.E.P. § 2144.03 (“While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection ... It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.”). In this instance, the Examiner’s sole rationale for using Official Notice to address aspects of claim 5 directed to the storage device comprising an audio recorder is that a cell phone has the “ability to pick up audio from a built in microphone that is used to transmit voice over a wireless connection” so the skilled artisan would “modify a cell phone to store the transmitted audio.” The relied upon device of the ‘169 reference (*i.e.*, the asserted storage device), however, is not a cell phone, but a memory card 10 that could be used with a cell phone (*see, e.g.*, Figure 1 and paragraph 0009). The Examiner fails to provide any explanation or reasoning why the skilled artisan would modify the memory card 10 of the ‘169 reference to include an audio recorder. As such, the Examiner’s attempted reliance upon Official Notice does not even address the limitations of claim 5. Accordingly, Appellant respectfully submits that the § 103(a) rejection of claim 5 is improper and requests that it be withdrawn.

VIII. Conclusion

In view of the above, Appellant submits that the rejections of claims 1-9 are improper and therefore requests reversal of the rejections as applied to the appealed claims and allowance of the entire application.

Authority to charge the undersigned's deposit account was provided on the first page of this brief.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Robert J. Crawford
Reg. No.: 32,122
651-686-6633
(NXPS.472PA)

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
(S/N 10/561,461)

1. A storage device for storing data pieces and comprising:
 - an input for receiving first data pieces having a first data format;
 - a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format;
 - a storage medium for storing a set of first data pieces and a subset of second data pieces; and
 - a processor for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to a reproduction device and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device.
2. A storage device as claimed in claim 1, wherein the processor is arranged to delete second data pieces stored in the storage medium in dependence of data piece priorities.
3. A storage device as, claimed in claim 1, wherein the data pieces are pieces of music, with the first data format corresponding with a first audio standard and with the second data format corresponding with a second audio standard, which first audio standard requires less storage capacity than the second audio standard.
4. A storage device as claimed in claim 1, wherein the reproduction device is coupled to the storage device via a wireless channel requiring data pieces to have the second data format.
5. A storage device as claimed in claim 1, wherein the storage device comprises an audio recorder and the reproduction device comprises one or more loudspeakers.

6. A system comprising a reproduction device and a storage device for storing data pieces and comprising:

- an input for receiving first data pieces having a first data format;
- a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format;
- a storage medium for storing a set of first data pieces and a subset of second data pieces; and
- a processor for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device.

7. A processor for use in a storage device for storing data pieces, which storage device comprises:

- an input for receiving first data pieces having a first data format;
- a transcoder for transcoding a first data piece into a second data piece having a second data format different from the first data format;
- a storage medium for storing a set of first data pieces and a subset of second data pieces; and
- the processor for searching for a predefined second data piece stored in the storage medium and for, in response to a positive search result, supplying the predefined second data piece to a reproduction device and for, in response to a negative search result, controlling the transcoder for transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device.

8. A method for supplying data pieces to a reproduction device and comprising the steps of:
 - receiving first data pieces having a first data format;
 - transcoding a first data piece into a second data piece having a second data format different from the first data format;
 - storing a set of first data pieces and a subset of second data pieces in a storage medium; and
 - searching the storage medium for a predefined second data piece for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device.

9. A processor program product for supplying data pieces to a reproduction device and comprising the functions of:
 - receiving first data pieces having a first data format;
 - transcoding a first data piece into a second data piece having a second data format different from the first data format;
 - storing a set of first data pieces and a subset of second data pieces in a storage medium; and
 - searching the storage medium for a predefined second data piece for, in response to a positive search result, supplying the predefined second data piece to the reproduction device and for, in response to a negative search result, transcoding a corresponding first data piece into the predefined second data piece and supplying the predefined second data piece to the reproduction device.

APPENDIX OF EVIDENCE

Appellant is unaware of any evidence submitted in this application pursuant to 37 C.F.R. §§ 1.130, 1.131, and 1.132.

APPENDIX OF RELATED PROCEEDINGS

As stated in Section II above, Appellant is unaware of any related appeals, interferences or judicial proceedings.